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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/435,072 05/08/95 SOMERS

M 70213

EXAMINER

03M1/0708

MARK A. MONTGOMERY
EASTMAN CHEMICAL COMPANY
PO BOX 511
KINGSPORT TN 37662

ART UNIT	PAPER NUMBER
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1017

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DATE MAILED: 07/08/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 3/25/96 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1 - 20 are pending in the application.
Of the above, claims 8 - 20 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1 - 7 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

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EXAMINER'S ACTION

Serial Number: 08/435072
Art Unit: 1317

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15. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1317.

16. This application contains claims 8-20 are drawn to an invention non-elected with traverse in Paper No. 7. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18.

Claims 1-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by McCoskey et al(5041251) for reasons as set forth in the previous office action , *inter alia*, including forming particles of particular characteristics (col 2, line 46; col 3, line 61-col 4, line 7; col 6, lines 40-48; col 7, lines 36-44; col 8, lines 29-30). Concerning claims 2 and 6, the cited reference teaches similar nonsticky material in col 5, lines 31-33. The examiner submits that such material would possess identical viscosity as claimed as such property would be

inherent. Concerning claim 7, the cited reference teaches similarly claimed steps in col 3, lines 11-21. Concerning claims 3-5, the examiner submits that such limitations directed to the particular exposed surface area of the resulting product are expressly drawn to article limitations and not believed germane in the instant question for patentability.

19.

Applicant's arguments filed 3-25-96 have been fully considered but they are not deemed to be persuasive. Applicant argue that 1) although the cited reference may disclose similar steps, the steps are not the same or in the same order as required in the claimed invention. The examiner would disagree because it is believed such recited McCoskey et al patent indeed teaches the identical steps as claimed and the applicant has failed to expressly show how the claimed steps differ from that of the cited reference. Applicant argue that 2) the claimed invention requires the coextrusion of an amorphous propylene copolymer in a sheath of a non-tacky polyolefin and points to portions of the submitted specification to support this argument. The examiner would respond by reminding applicant that such article structural limitations weren't claimed. Although such product limitations can be found as examples or embodiments in the specification, it was not claimed explicitly. Nor were the words that are used in the claims defined in the specification to

require these limitation. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. The examiner's intent was not to reject portions of the specification but the claims as submitted for examination, if applicable. In conclusion, it appears that the applicant is arguing that the submitted claims should be allowed, i.e., presenting conclusion, but fails to show how such claims differ from the teachings and/or suggestions of the cited *McCoskey et al* patent (i.e., fails to provide evidence to that effect). 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the references.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE

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MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Crystal Mall 1 Fax Center

A facsimile center has been established in Crystal Mall 1 . The hours of operations are Monday through Friday, 8:45 AM to 4:45 PM. This new location should be used in all instances when faxing any correspondence to Group 1300. The Patent Examining Fax Center new telecopier number is (703) 308-0039. Use of the new Crystal Mall 1 center will facilitate rapid delivery of materials to the group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989).

Any inquiry concerning this communication should be directed to Merrick Dixon at telephone number (703) 308-0013.



Merrick Dixon

Group 1300